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MS APPEAL BRIEF - PATENTS
PATENT
2091-0145P
2/3/04

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Kazuo SHIOTA et al.

Appeal No.:

Appl. No.: 08/979,567

Group: 3622

Filed: November 26, 1997

Examiner: J. YOUNG

Conf.: 5872

For: PHOTOGRAPHIC PRINT ORDERING METHOD,
SYSTEM, AND MEDIUM

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REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 30, 2003

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on November 3, 2003.

- ☐ An extension of time under 37 C.F.R. § 1.136(b) to _____ was requested on _____ and was approved on _____.

- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

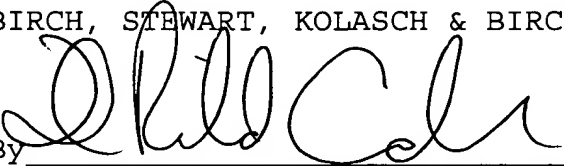


Appl. No. 08/979,567

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)

(Rev. 09/30/03)



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ON BEHALF OF APPELLANTS
KAZUO SHIOTA et al.

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 30, 2003

Sir:

This Reply Brief is in response to the Examiner's Answer mailed November 3, 2003.

Basis for Filing This Reply Brief

Appellants respectfully submit this Reply Brief in response to new points of argument raised in the Examiner's Answer, particularly those set forth in the section entitled "Response to Arguments" on pages 7-9 of the Examiner's Answer.¹

¹ Although the Grounds of Rejection section of the Examiner's Answer includes a paragraph titled "Response to Arguments," it appears that this paragraph was copied from pages 2-3 of the Final Office

More specifically, in reply to Appellants' argument that the outstanding rejection based on the asserted combination of *Moghadam et al.* (U.S. Patent 5,799,219, hereinafter "*Moghadam*") in view of *Farros et al.* (U.S. Patent 5,930,810, hereinafter "*Farros*") fails to establish *prima facie* obviousness, the Examiner states:

Initially, the Examiner felt that a so-called "updateable order screen" feature was not explicit[ly] recited in *Moghadam et al.* However, upon closer inspection this is clearly taught and explicitly recited by *Moghadam et al.* [Examiner's Answer, pgs. 7-8].

The Examiner's Answer goes on to discuss aspects of *Moghadam* that allegedly support the Examiner's most recent view of the teachings of *Moghadam* in relation to claimed subject matter. As detailed below, Appellants respectfully submit that the Examiner's current interpretation of the teachings of *Moghadam* mischaracterizes the reference and are not supported by objective evidence. For at least the reasons set forth in the Appeal Brief of August 18, 2003, and the additional comments presented below in direct response to the new points of argument raised in the Examiner's Answer, Appellants respectfully submit that the outstanding prior art rejection fails to establish *prima facie* obviousness of any pending claim.

Response to New Points of Argument Raised by the Examiner's Answer

1. Review of Claimed Subject Matter

By way of review, claims 1-3, 5-8, 10-15, 17-21, and 23-33 remain pending, with claims 1, 6, 11-13, 19, and 25-27 being independent. No claims have been allowed. The features of the various claims, particularly the independent claims, have been detailed

Action dated February 25, 2003. The Examiner's characterization of the prior art teachings therein have been addressed in Appellants' Appeal Brief dated August 18, 2003.

in the Appeal Brief dated August 18, 2003. As an example of the claimed subject matter, independent claim 1 is directed to a picture print ordering method for ordering a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system. The picture print ordering method of claim 1 comprises: recording high resolution picture image data obtained by reading a developed film and printing service information regarding the printing service which can be provided for the high resolution picture image data in the same portable recording medium, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user selects; displaying the printing service information and the image data recorded in the portable recording medium so as to display the order screen when the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated; and generating the print ordering information by using the displayed printing service information. Claim 1 specifies that the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

Thus, the picture print ordering method of claim 1 records high resolution picture image data and printing service information, which is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects, on the same portable recording medium. Storing the "printing service information" in an updateable form on the recording medium along with the high

resolution picture image data allows such information to be updated by the service provider upon fulfilling print orders, thereby enabling the user to subsequently generate print order information in accordance with the current printing capabilities of the service provider at the time of ordering prints. For example, as illustrated in Fig. 2, the updated printing service information recorded on the recording medium may be used to generate an updated menu ("order screen") of services associated with picture image data when there has been a change in printing service options available.

Dependent claim 28 further specifies that "the printing service information is updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen." As shown for example in Fig. 2 of the present application, the updated printing service information provided to the user on the portable recording medium, along with the high resolution picture image data, may be used to generate an updated order screen, which differs from a previously-presented order screen used by the customer to generate the previous print order.

Deficiencies in the Asserted Grounds of Rejection

As previously discussed, *Moghadam* is directed to a system for ordering digital prints remotely, e.g., via a network or facsimile. In one embodiment illustrated in Fig. 4, a photo finishing center 50 includes an order entry system 30 ("retail counter"), a photo finishing work station 42, a photographic printer 46, and a central computer 48, which includes digital image storage 44 and a communication channel 72 with a customer's home computer 68. In this embodiment, the home user accesses digital photographs

stored at the central computer 48 as well as a digital index image 84 via the communication channel 72. The home user may print out the digital index image 84, handwrite an order, and fax it to the photo finisher. (Col. 5, lines 39-46).

The Examiner asserts on page 8 of the Examiner's Answer that one embodiment of *Moghadam* specifies that the photo finishing station may provide the user with a photo CD with digital picture information stored thereon. The Examiner cites Fig. 5 as allegedly teaching that such a recording medium would also include updateable print service information of the type claimed. Appellants submit that such an assertion attributes features to the system of *Moghadam* that a detailed reading of the reference reveals are not taught therein.

More specifically, although it is apparent that *Moghadam* contemplates storing digitized picture data on a CD-ROM 144, the reference does not teach or suggest using such a portable recording medium to store, along with the high resolution picture image data, printing service information of the type claimed, which is updateable information for use in generating an updateable order screen displaying available printing services from which a user selects. Although the Examiner cites Fig. 5 as allegedly illustrating updateable print service information indicating printing services from which a user selects, the reference does not teach or suggest that such ordering information is stored on the CD-ROM 144 or that such information is updateable to indicate printing services which can be provided for the high resolution picture image data on the portable recording medium. To the contrary, *Moghadam* is clearly directed to a system in which information is provided to the user via a network, for example as clearly indicated by the paragraph immediately preceding the description of Fig. 5 at col. 5 of *Moghadam*. (Col.

5, ll. 60-65). Furthermore, even if the print order information contained in the display screen of Fig. 5 were provided via the CD-ROM (which Appellants do not admit), such fields are not the updateable printing service information of the type claimed in claim 1 for generating an updateable order screen displaying available printing services from which a user selects, which is specified in claim 1 as including "a plurality of attributes including size and kind and name of an apparatus and/or service provider by which the printing service information has been recorded in the portable recording medium." Furthermore, with regard to dependent claim 28, there is no indication that this information is "updated printing service information for updating the order screen and/or deleting a service which cannot be provided to the user from the order screen."

The Examiner's reliance on *Farros* fails to make up for these deficiencies.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. *Uniroyal, Inc. v. Rudlan-Wiley Corp.*, 5 USPQ 1434 (Fed. Cir. 1983).

As evident from reasoning set forth in the Federal Circuit's recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), the factual question of obviousness cannot be resolved merely on subjective belief and unknown authority, and instead must be based on the objective evidence of the record. The Examiner bears the burden of establishing objective factual findings of the record to support a finding of obviousness. *Id.* at 1433. Appellants respectfully submit that the Examiner's Answer fails to establish *prima facie* obviousness because a review of the prior art reveals that the claimed features are not taught therein, contrary to the assertions that form the basis of the rejection.

For at least these reasons and the reasons set forth in the Appeal Brief dated August 18, 2003, the Examiner has failed to satisfy the burden of establishing objective factual findings of the record to support a finding of obviousness and has mischaracterized the teachings of the prior art. Thus, the asserted grounds of rejection fails to establish *prima facie* obviousness of any pending claim.

Conclusion

For the reasons set forth above and for the reasons contained in the original Appeal Brief, Appellants respectfully submit that all claims of the present application are allowable. Thus, favorable reconsideration and reversal of the Examiner's rejection of claims by the Honorable Board of Patent Appeals and Interferences is respectfully requested.



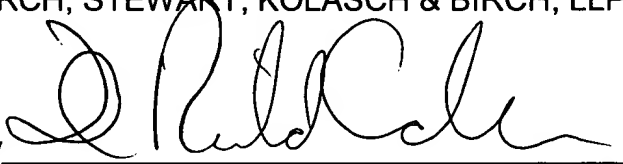
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Atty. Docket No. 2091-0145P

Should there be any outstanding matters that need to be resolved in the present Appeal, the Examiner or Honorable Board is respectfully requested to contact the undersigned at (703) 205-8035.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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